

REMARKS

Claims 1-17 are pending. Claims 3, 4 and 12-17 are found allowable subject to being rewritten in independent form.

Claims 1 and 8 have been rejected under 35 U.S.C. 102(e) as being anticipated by Foley.

This rejection is respectfully traversed for the following reasons.

It is well settled that the Examiner bears the initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention under any statutory provision. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Anticipation under 35 U.S.C. § 102 requires the disclosure in a single reference of each element of a claimed invention. *Minnesota Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). In rejecting a claim under 35 U.S.C. § 102, it is incumbent upon the Examiner to point out specifically wherein an applied reference discloses each feature of the claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). It is respectfully submitted that the Examiner did not discharge that burden.

In particular, claim 1 recites a method of configuring a transceiver for providing data communications via residential telephone line wiring, the method comprising the steps of:

transmitting a pulse signal having a selected amplitude by a transmit section of the transceiver,

receiving the pulse signal by an input circuit in a receiver section of the transceiver to produce a receive signal representing the pulse signal, and

adjusting gain of the input circuit so as to produce the receive signal at a predetermined level.

Independent claim 8 recites a transceiver for providing data communications over residential telephone line wiring, comprising:

- an input circuit for receiving an incoming signal,
- an output circuit for transmitting a transmit signal having a selected amplitude, and
- a calibration circuit responsive to a receive signal produced by the input circuit in response to the transmit signal for adjusting gain of the input circuit so as to set the receive signal to a predetermined level.

The Examiner has failed to point out specifically wherein Foley discloses each feature recited in the claims. Instead, he relied upon col. 8, line 30 through col. 11, line 65 and figures 5-7.

It is noted that this portion of the reference describes the entire arrangement of receive and transmit sides of a modem.

It is respectfully submitted that Foley does not disclose the claimed calibration circuit responsive to the receive signal produced by the input circuit of a transceiver in response to the transmit signal (produced by the output circuit of the transceiver) for adjusting gain of the input circuit, as claim 8 requires.

Also, Foley does not disclose the claimed steps of:

- receiving the pulse signal (transmitted by the transmit section of a transceiver) by an input circuit in the receiver section of the transceiver to produce a receive signal representing the pulse signal, and

- adjusting gain of the input circuit so as to produce the receive signal at a predetermined level, as claim 1 requires.

Considering the reference, Foley discloses gain control amplifier 601 (FIG. 6) at the input of receive side 600 of modem 503 or 513. The reference indicates that the amplifier 601 adjusts

the voltage of the received signal to bring this signal into a preferred range for linear sampling by analog-to-digital converter 603 (col. 8, lines 58-62).

Also, Foley discloses that the receive side 600 also includes automatic gain control 607 that controls the amplifier 601 if the amplifier 601 is located externally with respect to the modem.

Further, Foley discloses transmit side 700 of the modem 503 or 513 for producing transmitted analog data.

Foley does not teach or suggest that the gain control amplifier 601 of the receive side 600 receives the data transmitted by the transmit side 700 to adjust its gain.

In the event the Examiner relied upon inherency without expressly indicating such reliance, the Examiner should be aware that inherency requires certainty, not speculation. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); *In re Oelrich*, 666 F.2d 578, 212 USPQ 323 (CCPA 1981); *In re Wilding*, 535 F.2d 631, 190 USPQ 59 (CCPA 1976). To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probability or possibilities. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The Examiner provided no factual basis upon which to conclude that the receive side 600 of Foley's modem necessarily receives the data transmitted by the transmit side 700 of this modem to adjust the gain of the receive side.

Moreover, one skilled in the art would realize that the receive side of a modem may be prevented from receiving data transmitted by the transmit side of this modem.

Hence, Foley neither expressly nor inherently discloses the invention recited in independent claims 1 and 8. Accordingly, it cannot be said that Foley describes the claimed invention within the meaning of 35 U.S.C. § 102. *Minnesota Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc., supra*. Applicants, therefore, respectfully submit that the rejection of claims 1 and 8 under 35 U.S.C. § 102 as anticipated by Foley is untenable and should be withdrawn.


Dependent claims 2, 5-7 and 9-11 have been rejected under 35 U.S.C. 103 as being unpatentable over Foley in view of Roberts. These claims are defined over the prior art at least for the reasons presented above in connection with the respective independent claims 1 and 8.

In view of the foregoing, and in summary, claims 1-17 are considered to be in condition for allowance. Favorable reconsideration of this application, as amended, is respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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